

Remarks

Claims 1-9, 11, and 12 have been canceled without prejudice or disclaimer, and new claims 13-34 have been added. Applicants hereby reserve the right to pursue canceled subject matter in subsequently filed continuing applications.

New claims 13-34 have been added in order to claim additional embodiments of the subject matter of the provisionally-elected group. Support for these claims can be found throughout the specification and original claims as filed, for example, at page

Accordingly, no new matter has been added and entry of the present amendment and remarks are respectfully solicited.

Original claim 10 and new claims 13-34 are pending.

The Restriction Requirement

Pursuant to the Office Action mailed April 5, 2006, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I-IV. The Examiner contends that the inventions are distinct, each from the other.

In response, Applicants provisionally elect, *with traverse*, the invention of Group I, represented by new claims 13-34, drawn to polynucleotides for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 1-9, 11, and 12 have been canceled without prejudice or disclaimer, and that new claims 13-34 are directed to subject matter falling within the ambit of Group I as cast by the Examiner.

With respect to the Examiner's division of the invention into four groups and the reasons stated therefore, Applicants respectfully disagree and traverse.

Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, the Examiner has argued that Groups I-IV have acquired a separate status in the art "in view of their different classification, different field of search and ... because of their recognized divergent subject matter..." *See*, page 3. Thus, the Examiner has argued that it would be allegedly burdensome to search any combination of the Groups together. Applicants respectfully disagree with the Examiner's reasoning.

Although Groups I-IV are arguably separately classified, Applicants nonetheless submit that a search of the claims of any of the groups would also provide useful information for the claims of the other groups. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein and methods of using the protein and the nucleic acids encoding such proteins. Thus, contrary to the Examiner's assertions, since the searches for proteins, nucleic acids encoding such proteins, and methods of using the protein and the nucleic acids encoding such proteins commonly overlap, the combined search and examination of such compositions would not entail a serious burden. Accordingly, in view of M.P.E.P. § 803, the claims of all of Groups I-IV should be searched and examined together in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

In addition to the restriction requirement outlined above, the Examiner has further required a species election should Group I be provisionally elected. *See*, page 3. In particular, the Examiner alleges that a species must be elected because the application contains claims to various patentably distinct mutations of SEQ ID NO:2. Although Applicants respectfully disagree that a species election is proper, Applicants note that claim 1 directed to said distinct mutations of SEQ ID NO:2 has been canceled without prejudice or disclaimer, rendering the Examiner's species election moot.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.


Conclusion

Entry of the above amendment is respectfully solicited. In view of the foregoing remarks, Applicants believe that this application is now in condition for examination, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

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Respectfully submitted,

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